

REMARKS

This Amendment is submitted in reply to the Non-Final Office Action mailed on February 9, 2009. The Office Action provided a three-month shortened statutory period in which to respond, ending on May 9, 2009. Accordingly, this amendment is timely submitted and no fee is due in connection with this Amendment. The Commissioner is hereby authorized to charge Deposit Account No. 50-4498 in the name of Nestle Nutrition for any fees that may be deemed owed or credit any overpayment.

The Applicant has fully considered the Office Action and cited references and submits this Reply and Amendment in response to the outstanding rejections. Reconsideration of the application for patent is requested.

Applicant does not acquiesce in the correctness of the rejections or objections and reserve the right to present specific arguments regarding any rejected or objected-to claims not specifically addressed. Further Applicant reserves the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application. Claims 12-30 are pending. Claims 1-11 were previously canceled without prejudice or disclaimer. Claim 27 was previously withdrawn. In the Office Action, Claims 12-14, 16-20, 24-26 and 28-30 are rejected under 35 U.S.C. §102. Claims 15, 19-21 and 23 are rejected under 35 U.S.C. §103. In response, Claims 12-13, 16, 18-19, 21, 24-25 and 28-29 have been amended and Claims 14-15, 22-23 and 26 have been canceled without prejudice or disclaimer. The amendments do not add new matter. In view of the amendments and/or for the reasons set forth below, Applicant respectfully submits that the rejections should be withdrawn.

Initially, Applicant notes that the Patent Office has objected to Claim 22 as being dependent from a rejected base claims that would be allowable if rewritten in independent form incorporating all the limitations of the rejected base claim and any intervening claims. See, Office Action, page 14, line 21-page 15, line 2. In response, Applicant has newly added Claim 31, which contains the subject matter of independent Claim 19 and dependent Claim 22. As such, Applicant submits that newly added Claim 31 is novel and nonobvious in view of the cited references and is in position for allowance.

In the Office Action, Claims 12-14, 16-18, 25-26 and 28-30 are rejected under 35 U.S.C §102(e) as being anticipated by WO03/026677 to Einarsson et al. ("*Einarsson*"). Specifically,

the Patent Office alleges that *Einarsson* discloses chito-oligosaccharides. See, Office Action, page 5, lines 19-21. However, Applicant respectfully submits that *Einarsson* is deficient with respect to the presently amended claims.

Currently amended independent Claims 12, 16, 18-19, 25 and 28-29 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. The amendments do not add new matter. The amendments are supported in the specification at, for example, page 7, lines 1-8. Applicant has surprisingly found that certain compounds including, but not limited to those disclosed above, survive passage through the gastrointestinal tract and inhibit the adhesion of specific pathogens to the colonic epithelium without adversely affecting the colonic microflora or adhesion of probiotic organisms. See, specification, page 1, lines 15-18. In contrast, however, Applicant respectfully submits that *Einarsson* fails to disclose each and every element of the present claims.

For example, *Einarsson* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16, 18-19, 25 and 28-29. Specifically, *Einarsson* fails to disclose or suggest compositions, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition as required, at least in part, by independent Claims 12, 16, 18-19, 25 and 28-29. Instead, *Einarsson* is entirely directed toward pharmaceutical compositions containing chito-oligosaccharides in the range of 20% to 100% by weight of the composition. See, *Einarsson*, page 11, lines 25-35. Since *Einarsson* fails to disclose or suggest the presently claimed compounds, *Einarsson* fails to anticipate the present claims.

In the Office Action, Claims 12-14, 16-18, 25-26 and 28-30 are rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,750,331 to Takaichi et al. ("*Takaichi*"). Specifically, the Patent Office alleges that *Takaichi* discloses compositions comprising oligosaccharides including lactosucrose, isomaltooligosaccharides, gentiooligosaccharides, mannooligosaccharides or chitooligosaccharides. See, Office Action, page 6, lines 8-10.

However, Applicant respectfully submits that *Takaichi* is deficient with respect to the present claims.

As discussed above, currently amended independent Claims 12, 16, 18, 25 and 28-29 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. In contrast, however, Applicant respectfully submits that *Takaichi* fails to disclose each and every element of the present claims.

For example, *Takaichi* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16, 18, 25 and 28-29. Specifically, *Takaichi* fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof as required, at least in part, by independent Claims 12, 16, 18, 25 and 28-29. Instead, *Takaichi* is entirely directed toward an oligosaccharide supplying composition that contains oligosaccharides that are distinguishable from the presently amended claims. See, *Takaichi*, Abstract. Since *Takaichi* fails to disclose or suggest the presently claimed compounds, *Takaichi* fails to anticipate the present claims.

In the Office Action, Claims 12-14, 16-18, 24-25 and 28-30 are rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,863,918 to Bindels et al. ("*Bindels*"). Specifically, the Patent Office alleges that *Bindels* discloses lactosucrose, mannose-based oligosaccharides, arabino-oligosaccharides, isomalto-oligosaccharides, and possibly lactose. See, Office Action, page 7, lines 6-9. However, Applicant respectfully submits that *Bindels* is deficient with respect to the present claims.

As discussed above, currently amended independent Claims 12, 16, 18, 24-25 and 28-29 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. In contrast, however, Applicant respectfully submits that *Bindels* fails to disclose each and every element of the present claims.

For example, *Bindels* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16, 18, 24-25 and 28-29. Specifically, *Bindels* fails to disclose or suggest fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof as required, at least in part, by independent Claims 12, 16, 18, 24-25 and 28-29. Instead, *Bindels* is entirely directed toward an infant formula aimed at reducing constipation, abdominal discomfort and gastrointestinal problems comprising oligosaccharides that are completely distinguishable from the presently claimed oligosaccharides. See, *Bindels*, Abstract; column 15, lines 23-36. However, since *Bindels* fails to disclose or suggest the presently claimed compounds, *Bindels* fails to anticipate the present claims.

In the Office Action, Claims 12-14, 16-18, 25 and 28-30 are rejected under 35 U.S.C §102(b) as being anticipated by "The prebiotic effects of biscuits . . ." to Touhy et al. ("*Touhy*"). Specifically, the Patent Office alleges that *Touhy* discloses a study of the effects of partially hydrolyzed guar gum and fructooligosaccharides on gut microflora in humans. See, Office Action, page 8, lines 3-4. However, Applicant respectfully submits that *Touhy* is deficient with respect to the present claims.

As discussed above, currently amended independent Claims 12, 16, 18, 25 and 28-29 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. In contrast, however, Applicant respectfully submits that *Touhy* fails to disclose each and every element of the present claims.

For example, *Touhy* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16, 18, 25 and 28-29. Specifically, *Touhy* fails to disclose or suggest compositions, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition as required, at least in part, by independent Claims 12, 16, 18, 25 and 28-29. Instead, *Touhy* is entirely directed toward the use of specific oligosaccharides to alter the composition of human colonic microflora. However, *Touhy* fails to disclose or even suggest that the compositions may include about 2.5% to about

10% of the compound by total weight of the composition. See, *Touhy*, Abstract. Since *Touhy* fails to disclose or suggest the presently claimed compounds, *Touhy* fails to anticipate the present claims.

In the Office Action, Claims 12-14, 16-18, 25 and 28-30 are rejected under 35 U.S.C §102(b) as being anticipated by WO00/49885 to Neeser et al. ("*Neeser*"). Specifically, the Patent Office alleges that *Neeser* discloses a composition and method for prevention or treatment of a bone or dental disorder comprising a milk protein hydrolysate. See, Office Action, page 8, lines 21-22. However, Applicant respectfully submits that *Neeser* is deficient with respect to the present claims.

As discussed above, currently amended independent Claims 12, 16, 18, 25 and 28-29 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. In contrast, however, Applicant respectfully submits that *Neeser* fails to disclose each and every element of the present claims.

For example, *Neeser* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16, 18, 25 and 28-29. Specifically, *Neeser* fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof as required, at least in part, by independent Claims 12, 16, 18, 25 and 28-29. Instead, *Neeser* is entirely directed toward compositions for the treatment of a bone or dental disorder which comprises a milk protein hydrolysate to inhibit bone resorption or bone loss, or favor calcium absorption, retention or calcification. See, *Neeser*, Abstract. Since *Neeser* fails to disclose or suggest the presently claimed compounds, *Neeser* fails to anticipate the present claims.

In the Office Action, Claims 12-17 and 24 are rejected under 35 U.S.C §102(b) as being anticipated by "Synthesis of α 1-6-Mannooligosaccharides in *Mycobacterium smegmatis*" to Yokoyama et al. ("*Yokoyama*"). Specifically, the Patent Office alleges that *Yokoyama* discloses α 1-6-Mannooligosaccharides and that the α 1-6-Mannooligosaccharides are "reasonably considered to be a pharmaceutical or nutritional composition according to the instant claims as it

could be administered to a subject to produce a therapeutic effect.” See, Office Action, page 14, lines 3-7. However, Applicant respectfully submits that *Yokoyama* is deficient with respect to the present claims.

Currently amended independent Claims 12, 16 and 24 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. In contrast, however, Applicant respectfully submits that *Yokoyama* fails to disclose each and every element of the present claims.

For example, *Yokoyama* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16 and 24. Specifically, *Yokoyama* fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition as required, at least in part, by independent Claims 12, 16 and 24. Instead, *Yokoyama* is entirely directed toward alpha 1-6 manno-oligosaccharides in *mycobacterium smegmatis*. See, *Yokoyama*, Abstract. *Yokoyama* fails to disclose the presently claimed oligosaccharides and makes no mention of the compositions having the oligosaccharide compounds present from about 2.5% to about 10% of the total weight of the composition. Since *Yokoyama* fails to disclose or suggest the presently claimed compounds, *Yokoyama* fails to anticipate the present claims.

In the Office Action, Claims 12-13, 16-20 and 29-30 are rejected under 35 U.S.C §102(b) as being anticipated by WO01/65949 to Baillon et al. (“*Baillon*”). Specifically, the Patent Office alleges that *Baillon* discloses a method of treating pathogenic bacteria in an animal by administering galactooligosaccharides and lactosucrose See, Office Action, page 13, lines 8-10. However, Applicant respectfully submits that *Baillon* is deficient with respect to the present claims.

Currently amended independent Claims 12, 16, 18-19 and 29 recite, in part, compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof.

In contrast, however, Applicant respectfully submits that *Baillon* fails to disclose each and every element of the present claims.

For example, *Baillon* fails to disclose or suggest any of the presently claimed compounds disclosed in currently amended independent Claims 12, 16, 18-19 and 29. Specifically, *Baillon* fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof as required, at least in part, by independent Claims 12, 16, 18-19 and 29. Instead, *Baillon* is entirely directed toward the use of non-digestible carbohydrates in the manufacture of a composition for treating pathogenic bacteria in the large intestine of a pet animal. See, *Baillon*, Abstract. However, *Baillon* fails to disclose or even suggest the presently claimed oligosaccharides. Since *Baillon* fails to disclose or suggest the presently claimed compounds, *Baillon* fails to anticipate the present claims.

Further, anticipation is a factual determination that “requires the presence in a single prior art disclosure of each and every element of a claimed invention.” *Lewmar Marine, Inc. v. Bariant, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (emphasis added). Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than all elements of a claimed invention are set forth in a reference. See, e.g., *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). As such, a reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found. Because the cited references fail to disclose each and every element of the present claims, the cited references fail to anticipate the present claims.

For at least these reasons, Applicant respectfully submits that *Einarsson*, *Takaichi*, *Bindels*, *Touhy*, *Neeser*, *Yokoyama* and *Baillon* all fail to anticipate the presently claimed subject matter.

Accordingly, Applicant respectfully submits that the anticipation rejections with respect to Claims 12-14, 16-20, 25-26 and 28-30 be reconsidered and withdrawn.

In the Office Action, Claims 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Touhy* in view of U.S. Patent No. 5,906,982 to Prieto et al. (“*Prieto*”). However, for at least the reasons discussed above with respect to *Touhy*, Applicant respectfully submits that *Touhy* fails to disclose or suggest every element of Claims 19-21. Specifically,

Touhy fails to disclose or suggest compositions, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. *Prieto* fails to remedy the deficiencies of *Touhy* because *Prieto* also fails to disclose or suggest compositions, wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. Instead, *Prieto* is entirely directed toward a nutritional formulation containing an effective amount of Lacto-N-neoTetraose to simulate the growth and/or metabolic activity of bifidobacterium. See, *Prieto*, Abstract. At no place in the disclosure does *Prieto* disclose or suggest wherein the composition comprises about 2.5% to about 10% of the compound by total weight of the composition. For at least these reasons, Applicant respectfully submits that the combination of *Touhy* and *Prieto* fails to render the presently claimed subject matter obvious.

In the Office Action, Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bindels*. Applicant respectfully submits that the patentability of Claim 12 as previously discussed, renders moot the obviousness rejection of Claim 15 that depends therefrom. In this regard, the cited art fails to teach or suggest all of the elements of Claim 15 in combination with the novel elements of Claim 12.

In the Office Action, Claims 19-21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bindels* in view of U.S. Patent No. 6,613,549 to Reid et al. ("*Reid*"). However, for at least the reasons discussed above with respect to *Bindels*, Applicant respectfully submits that *Reid* fails to disclose or suggest every element of Claims 19-21. Specifically, *Bindels* fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof. *Reid* fails to remedy the deficiencies of *Bindels* because *Reid* also fails to disclose or suggest compositions comprising a compound selected from the group consisting of methyl manno-oligosaccharides, partially hydrolysed guar gum, long-chain isomalto-oligosaccharides, and combinations thereof. Instead, *Reid* is entirely directed toward probiotic microbes and fails to disclose or suggest the presently claimed oligosaccharides. See, *Reid*, Abstract. For at least these reasons, Applicant respectfully submits that the combination of *Bindels* and *Reid* fails to render the presently claimed subject matter obvious.

Accordingly, Applicant respectfully submits that the obviousness rejections with respect to Claims 15, 19-21 and 23 be reconsidered and withdrawn.

For the foregoing reasons, Applicant respectfully requests reconsideration of the above-identified patent application and earnestly solicits an early allowance of same. In the event there remains any impediment to allowance of the claims, and a telephone interview would be of assistance in advancing the prosecution of the application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

Nestlé Healthcare Nutrition
12 Vreeland Road, 2nd Floor
Florham Park, NJ 07932
(973) 593-7553

By: 

Gary M. Lobel
Attorney for Applicant
Reg. No. 51,155

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